

## **REMARKS**

The present Amendment is in response to the Examiner's Office Action mailed August 9, 2004. Claim 1, 11-13, and 27 are amended. Support for the amendments can be found in the specification at paragraph 55. Claims 1-13 and 15-45 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Also, Applicant's arguments related to each cited reference are not an admission that the cited references are, in fact, prior art.

### **A. Claim Objections**

Claims 13 and 27 have been indicated by the Examiner being substantial duplicates, and therefore subject to a future objection under 37 CFR 1.75 should claim 13 become allowable. Applicants respectfully traverse.

It is well known that means language provides a specialized meaning in patent law, one that is different from structural language. For example, the patent statute recites:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 112(6). Means language thus invokes a review of the specification to identify corresponding structure, material, or acts and equivalents thereof. Claim limitations not reciting means language stand in contrast in that a review of specification to identify the corresponding structure et al. is not performed. In other words, although means language and structural language may cover some of the same subject matter, they differ in scope and application.

Accordingly, by way of example of differences between the claims, claim 13 recites, “a light delivery and collection means” in contrast to claim 27’s recited, “an optical module.” Although these recitations may cover certain of the same devices, it is not necessarily the case that the language covers exactly the same devices. As a result, for this reason and others not currently enumerated for simplicity in responding to the objection, Applicants respectfully submit that claims 13 and 27 are not substantial duplicates.

B. Rejections Under 35 U.S.C. § 102(b)

Claims 1-8, 11-13, 15-24, and 27-45 were rejected under the judicially created doctrine of obviousness-type double patenting as being anticipated by *Bernstein et al.* (U.S. Patent No. 5,873,831). Applicants respectfully traverse.

Present claim 1 recites, *inter alia*: “the inelastically scattered light having a plurality of Raman signals corresponding to the one or more macular carotenoids . . . analyzing the spatial position and intensity of the Raman signals . . . producing an image of the Raman signals, the image representing the spatial distribution and concentration level of the one or more macular carotenoids at a plurality of data points.” (emphasis added). As noted in the specification, the image representing the spatial distribution is collected from a plurality of data points. For example, 6,232 Raman data points were collected in Example 2 at paragraph 55. This imaging mode is advantageous over single point measurements for the various reasons outline in the Specification, see for example at paragraphs 47-49.

In contrast, *Bernstein* does not teach producing an “image representing the spatial distribution and concentration level of the one or more macular carotenoids.” Rather, *Bernstein* discloses an inherently single point measurement which does not lead to an image representing spatial distribution and concentration levels. Accordingly, the prompt removal of the rejection of claim 1 is respectfully requested. The remaining independent claims are patentable over *Bernstein* for similar reasons, each reciting language related to creating an image representing the spatial distribution and concentration level of the one or more macular carotenoids at a plurality of data points. Each of the dependent claims contain the limitations of the parent independent claims and are therefore also allowable

over *Bernstein* for at least the reasons cited above with respect to claim 1. Accordingly, the removal of the rejection of claims 1-8, 11-13, 15-24, and 27-45 is respectfully requested.

C. Rejections Under 35 U.S.C. § 103(a)

Claims 9, 10, 25, and 26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Bernstein* in view of U.S. Publication No. US2003/0004419 to Treado et al ("*Treado*").

Although Applicants maintain that claims 9, 10, 25, and 26 would not have been obvious over the cited references for at least the reason that the parent independent claims are patentable over the cited references and for the reasons set forth in the response filed on March 30, 2005, Applicants have submitted herewith a Declaration under 37 C.F.R. § 1.131 (hereafter "the Declaration") to remove *Treado* as a reference, in order to expedite prosecution of the present application.

Applicants note that the earliest possible effective date of *Treado* as a reference, assuming the provisional provides support for the cited disclosure of *Treado*, which applicants do not concede, is the provisional filing date of June 28, 2001. June 28, 2001 is less than one year before the filing date of the original parent application.

As indicated in the attached Declaration and supported by the accompanying exhibit, prior to June 28, 2001, inventor Werner Gellerman conceived and reduced to practice the idea of the methods and devices for imaging the spatial distribution and concentration level of pigments as described in the original parent application and claimed in the present application. Copies of invention disclosure documents and spatial

Raman images create prior to June 28, 2001, describing and showing the inventive concepts of the presently claimed invention are attached as Exhibit A to the Declaration.

Accordingly, the attached declaration shows that the invention claimed in the present application was conceived and reduced to practice prior to the effective date of *Treado* as a reference. Thus, Applicants respectfully request that the foregoing rejection be removed. Applicants therefore respectfully request that the rejection of claims 9, 10, 25, and 26 under 35 U.S.C. § 103(a) be withdrawn.

### **CONCLUSION**

In view of the response and amendments submitted herein, Applicant respectfully submits that each of the pending claims is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully invited to initiate the same with the undersigned attorney.

Dated this 8th day of November, 2005.

Respectfully submitted,



WILLIAM J. ATHAY  
Attorney for Applicant  
Registration No. 44,515  
Customer No. 022913